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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/676,170 | 10/02/2003 | Ross J. Hamel | 8932-684-999 | 6800 |

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JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

| EXAMINER | |
|---|---|
| KILKENNY, PATRICK L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3732 | |

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/676,170 | HAMEL, ROSS J. | |
| | Examiner | Art Unit | |
| | Patrick J. Kilkenny | 3732 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,4-7,9-17,19,21,23,25-36,41,44-50 and 52-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-7,9-17,19,21,23,25-36,41,44-50 and 52-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9-10-04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Farley et al. (5,984,865). Farley discloses a prior art surgical retractor with a handle (Fig. 2, #23), a first coupling mechanism adjacent to the proximal end of the handle (Fig. 2, #'s 21 and 57), and a blade (Fig. 2, #55) with a coupling element (Fig. 2, #59) dimensioned to connect with the first coupling mechanism. The coupling mechanism consists of a knob and a bore (Fig. 2, #'s 21 and 25) that engage, and rotate on, the shaft comprising the coupling element on the blade (Fig. 2, #59).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Taylor et al. (5,944,736). Farley et al. discloses the claimed invention with the exception of the shaft and the bore compromising mating threads for releasably advancing the shaft within the bore. Taylor et al. discloses a retractor where the surgical blade has a threaded shaft portion (Fig. 23, #313) that is threadably coupled within the bore of a knob (Fig. 23, #315). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shaft and bore of Farley et al. with mating threads, as taught by Taylor et al., to allow the blade to be detachable when needed and fully secure when operating the retractor. Furthermore, it is well known in any art that a threaded mating system is a common way to secure detachable elements.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. Farley et al. discloses the claimed invention with the exception of an opening in the handle to receive the knob. However, Farley et al. discloses and opening in the knob to receive the handle (Fig. 2, #21). Therefore, it would have been obvious to modify the handle of Farley et al with a hole to receive the knob, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

Claims 7 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Greenberg (5,558,622). Farley discloses the claimed invention with the exception of an aperture at the end of the retractor blade and "C" or "L" hook shapes at the distal end of the blade for stabilization against bone. Greenberg

discloses a surgical retractor where the blade has an aperture at the distal end (Fig. 10, #60). The aperture is dimensioned to receive either a surgical tool or an orthopedic implant (Fig. 17, #D). Greenberg also discloses both "C" and "L" hook-shaped distal ends of the retractor blade that help stabilize the blade against bone (Fig. 5, #58; Fig. 17, #M, and Fig. 20, #71B). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor blade of Farley et al. with an aperture and a distal shape that allows for stabilization against bone, as taught by Greenberg, since this would allow surgical tools and orthopedic implants during, which are commonly used during retraction procedures, to be introduced more to locations that are being manipulated by the retractor. It is also well known in the art to modify the terminal end of retractors with a structure to enhance contact with retracting surfaces.

Claims 14-17, 19, 23, 25-27, 52-53, 55-59 are rejected under 35 U.S.C. 102(b) over Farley et al. in view of Adair (4,905,670). Farley et al. discloses the claimed invention with the exception of having a second coupling mechanism including a coupling member, a second member, and a recess for attachment of an endoscope. Adair discloses a second coupling mechanism on the handle that couples to an endoscope (Fig. 4, #32) for view the distal end of the retractor blades. The coupling mechanism consists of a coupling member (Fig. 4, #36) received within and spaced from the handle. The coupling member contacts a second member (Fig. 4, #34), which contacts the handle. The coupling member and the second clamping member , not in contact with the handle, operatively associated for fixation of the endoscope on the

handle. The coupling member (Fig. 4, # 36) comprises numerous small recesses, or through holes, for clamping to a portion of the endoscope (Fig. 4, #40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. with a second coupling mechanism, as taught by Adair, since it is known in art to attach various secondary instruments (i.e. and endoscopte) to retractors, and this would require a secondary coupling mechanism.

Claim 19 and 21 are rejected under 35 U.S.C. 102(b) over Farley et al. in view of Wilder et al. (4,562,832). Farley et al. discloses the claimed invention with the exception of a second coupling mechanism where the mechanism comprises a coupling member (#39) that is received telescopically within the handle. Wilder et al. discloses a surgical retractor (Fig. 6) with a handle, a first coupling mechanism adjacent to the proximal end of the handle (pivot at end of handle), a blade member (#38), and a coupling element to couple with first coupling mechanism (blade component engaged with pivot of handle). There is also a second coupling mechanism where the mechanism comprises a coupling member (#39) that is received telescopically within the handle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. with a second coupling mechanism, as taught by Wilder et al., since it is known in art to attach various secondary instruments to retractors, and this would require a secondary coupling mechanism.

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. Farley et al. discloses the claimed invention with the exception of another

retractor blade having a coupling element for connecting with the first coupling mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. with a second retractor blade, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Hipps et al. (6,228,025). Farley et al. discloses the claimed invention with the exception of having a second handle transverse to the longitudinal axis. Hipps et al. discloses as surgical retractor with a second handle transverse to the longitudinal axis of the first handle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. with a second transverse handle, as taught by Hipps et al., since adding an additional handle will increase the ability to manipulate and more securely grasp the retractor.

Claims 31-36, 40-41, 44-47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Greenberg as applied to claim 7-13 above, and further in view of Adair. Farley et al. in view of Greenberg discloses a surgical retractor as described above. Greenberg also discloses a method for treating a bone. The method includes providing the surgical retractor, making an incision in the soft tissue and elevating the tissue off the bone (Fig. 17, S, SI, OI and M), passing a portion of the blade through the incision and retracting the tissue (Fig, 17, OI), circumventing at least part of the bone with a portion of the blade and stabilizing a portion of the blade on

the bone (Fig. 17, #'s 58, 59, and M), and performing a surgical procedure on the bone (Fig. 17, D and P). Part of the procedure involves using a surgical tool (D) to pass an orthopedic implant (P) through the cavity (SI) and the aperture of the blade (Fig. 17, #60). The surgical instrument can be a drill (and therefore a burr) (Column 6, lines 22-27) inserted through a drill guide or cannula (Column 2, lines 14-19). The implant secured to the bone can be a bone fastener or a screw (Column 6, lines 22-27) and used in an orthognathic procedure to fixate a fracture (Claim 32) on a bone segment (mandible) that comprises a condylar neck and a ramus. Farley et al. in view of Greenberg does not disclose providing and endoscope secured to the blade member of for viewing the bone segment. Adair discloses attaching an endoscope to a retractor for facilitating the target viewing area (Fig. 1, #32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. in view of Greenberg with an attached endoscope, as taught by Adair, to facilitate the viewing area of the site that bone surgery is being performed. Furthermore, it is well known in the art to use endoscopes in combination with retractors for various surgical procedures.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Greenberg, and further in view of Adair, as applied to claim 31 above, and further in view of Swaniger. Farely et al. in view of Greenberg, and further in view of Adair, discloses the claimed methods with the exception using a grafting procedure. Swaniger discloses methods for mandibular surgery that are well known in the art including a grafting procedure (Column 1, lines 21-24), using a biocompatible bone filler

material (Column 1, lines 30-38), and the use of a syringe to implant the bone filler material (Column 2, lines 10-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of Farley et al. in view of Greenberg, and further in view of Adair, with the use of these materials, as taught by Swaniger, for a mandibular procedure that is well known in the art.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al. in view of Adair as applied to claim 52 above, and further in view of Wilder. Farley et al. in view Adair discloses the claimed invention with the exception of a second coupling mechanism where the mechanism comprises a coupling member that is received telescopically within the handle. Wilder discloses second coupling mechanism where the mechanism comprises a coupling member (#39) that is received telescopically within the handle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the retractor of Farley et al. with a second coupling mechanism that is telescopically received in the handle, as taught by Wilder et al., since it is known in art to attach various secondary instruments to retractors, and this would require a secondary coupling mechanism. Furthermore, having the mechanisms received within the handle eliminates a protrusion on the handle caused by an attached coupling mechanism that may snag be a hindrance during use.

***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 9-17, 19, 21, 23, 25-36, 40-41, and 44-50, have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Kilkenny whose telephone number is (571) 272-8684. The examiner can normally be reached on Mon-Fri, 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J. Kilkenny
Art Unit 3732
May 12, 2006
5/12/06

PJK

PATRICIA BIANCO
PRIMARY EXAMINER
5/15/06